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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,181

05/23/2000

Paul Lapstun

NPA075US

9167

24011 7590 01/06/2009  
SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

01/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/575,181	<b>Applicant(s)</b> PAUL LAPSTUN	
	<b>Examiner</b> Lalita M. Hamilton	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-23, 25-31, 36-46 and 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-23, 25-31, 36-46 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 1-3, 8-23, 25-31, 36-46, and 48 is withdrawn in view of the newly discovered reference(s) to Wellner (5,640,193). Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-23, 25-31, 36-46, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Wellner (5,640,193).

Wellner discloses a multimedia service access by reading marks on an object comprising a method of supporting a user in performing online bill payment, the method including the steps of, in a computer system: maintaining a page description corresponding to a printed form, said printed form including information relating to a bill paying transaction, and coded data printed as a collection on tags, each tag being indicative of an identity of the form and of a location of the tags on the form, at least some of the coded data being coincident with the information, receiving, indicating data from an optically imaging pen operated by the user, the indicating data being indicative of the identity of the form and of a position of a nib of the pen relative to the form, the indicating data having been generated by the pen using at least some of the coded data

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it sensed when placed in an operative position relative to the form, retrieving the page description using the identity of the form, and identifying from the position of the nib and the retrieved page description, at least one parameter relating to the bill paying transaction: wherein the position of the nib is computed using an observed perspective distortion on an imaged tag and known geometry of pen optics (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); at least one parameter relating to the bill paying transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone indicated by the position of the nib as indicated by the indicating data, said at least one parameter (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); indicating data includes movement data indicative of movement of the pen relative to the form, the pen having generated the movement data using at least some of the coded data, and wherein the at least one parameter is identified in the computer system by determining that the movement was at least partially within said at least one zone (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); at least one parameter is an action parameter of the bill paying transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the action parameter of the bill paying transaction is selected from the group comprising: requesting information relating to a bill, initiating bill payment, resetting the form, electronically forwarding a bill, paying a bill, printing a bill,

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canceling a bill payment, listing due bills, listing or adding billers, listing, adding or removing payment methods and listing or removing failed bills (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the at least one parameter is an option parameter of the bill paying transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the pen and effecting, in the computer system, an operation associated with the option parameter (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the option parameter is associated with at least one of: a payment method, card type, bill payment line, autopay option, and account type (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); at least one parameter is a text parameter of the bill paying transaction, the method including identifying, in the computer system, that the user has entered handwritten text data by means of the pen and effecting, in the computer system, an operation associated with the text parameter (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); converting, in the computer system, the handwritten text data to computer text (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the text parameter is associated with at least one of: payment limit, account name, account number, cardholder name, card expiry date, autopay limit, payment amount and payment date (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); which the at least one parameter is an authorization parameter

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of the bill paying transaction, the method including identifying, in the computer system, that a payer has entered a handwritten signature by means of the pen, and effecting, in the computer system, an operation associated with the authorization parameter (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); includes verifying, in the computer system, that the signature is that of the payer (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the authorization parameter is associated with payment authorization, listing due bills, listing all bills, listing billers, listing payment methods, listing failed bills, adding a payment method and adding a biller (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the indicating data relates to a request, that a bill be printed locally (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); a portion of the coded data is superimposed with a visual graphic, the visual graphic relating to the parameter associated with the portion (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the form is a bill (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); supplying the form as part of a product or its packaging (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the product is a printed periodical (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); includes printing the coded data to be invisible in the visible spectrum (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6,

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line 5); distribution of a plurality of the forms using conventional mail (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); the pen contains an identification means which imparts a unique identity to the pen and identifies it as belonging to the user and in which the method includes monitoring, in the computer system, said identity (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); providing all required information relating to the bill paying transaction in the form to eliminate the need for a separate display device (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5); and form is printed on multiple pages and in which the method includes binding the pages (fig.2-4; col.1, lines 32-53; col.2, line 65 to col.3, line 13; col.4, lines 25-45; and col.5, line 28 to col.6, line 5).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lalita M Hamilton/  
Primary Examiner, Art Unit 3691